

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/723,247 Confirmation No. 3907

Applicant: David Bar-Or

Filed: November 25, 2003

TC/A.U.: 1653

Examiner Samuel Liu

Docket No.: 4172-82

Customer No.: 22442

For: "Treatment of diseases and conditions  
mediated by increased phosphorylation"

Commissioner for Patents

P.O. Box 1450

Alexandria VA 22313-1450

**RESPONSE**

Sir,

This response is being filed in response to the Office Action mailed March 27, 2006. No fees are believed to be due in connection with this Response to Restriction Requirement. However, in the event that fees are due, please debit Deposit Account No. 19-1970.

In this Office Action, the Examiner requires restriction to one of nine groups of claims. Applicant's hereby elect the Examiner's Group 3 (Claims 46-75, 79-81) without traverse. It is Applicant's understanding that method of use claims that depend from a composition claim found to be allowable or that otherwise include all the limitations of the patentable product will be rejoined as explained by the Examiner at page 7 of the Office Action.

The Examiner has also imposed what is referred to as an "Additional Election" as described at page 5 of the Office Action. As noted by the Examiner, this additional election is not considered to be a species election by the Examiner, but instead, further groupings of claims

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for an additional restriction requirement. With respect to these “Additional Elections,” Applicants elect phosvitin with traverse.

While Applicants submit that the “Additional Election” for Group 3 of the initial restriction requirement would be appropriate as a species election, it is both confusing and inappropriate as a second level of restrictions within a broader restriction group.

Initially, this second restriction - within the broader restriction Group 3 - is very confusing. As the Examiner has indicated that this is not a species election, there is presumably a separate grouping of claims within Claims 54-64 that would be made in response to Applicant’s response to the Additional Election, yet there is no indication of how the Examiner proposes to split the claims into separate groups. Is it the Examiner’s position that claims to casein or albumin will be cancelled by Examiner’s amendment if one of these molecules is not chosen? As the Examiner has not specified what groupings of claims are to be distinguished based on the “structure and function of casein,” Applicants submit that it is not clear how the claims are to be treated in view of any response made to this Additional Election. For this reason alone, Applicants submit that the Examiner’s “Additional Elections” are inappropriate as they do not provide any indication as to how the claims will be reviewed, withdrawn or cancelled based on any response by Applicants.

Additionally, Applicants note that the individual compounds the Examiner has taken exception to fall within the Markush group of phosphate acceptor compounds (PACs, IPACs, or EPACs) that have common features - specifically, they act as phosphate accepting molecules, and are indicative and useful in the treatment of diseases mediated by the phosphorylation of

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normal substrates by kinases. Any of the named PACs in claims 54-64 can function in this capacity, although the structure of the individual PAC compound may be distinct. Thus, these compounds all share a common functional role in the claimed technology recited in Claims 54-64. Therefore, Applicants submit that these "Additional Elections" described by the Examiner at page 5 of the Office Action are inappropriate as a further restriction requirement.

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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Date: April 27, 2006